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EXAMINER

RUST, ERIC A

ART UNIT

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2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,502	Applicant(s) SIEMENS ET AL.	
	Examiner ERIC A. RUST	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/02/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In the preliminary amendment filed June 02, 2006, claims 1-25 were canceled and claims 26-50 were added. Accordingly, claims 26-50 are pending in this application.

Priority

2. Acknowledgment is made of Applicants' claim for foreign priority under 35 U.S.C. 119(a)-(d). However, the certified copy of Application No. 103 57 490.5, filed on December 09, 2003, in the German Patent Office, has NOT been received by the Office.

Information Disclosure Statement

3. The information disclosure statement filed June 02, 2006 fails to comply with 37 CFR 1.98(a)(3), which requires a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language, and a copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c). The IDS has been placed in the application file, but the information referred to therein, specifically document DE 695 15 923 T2, has not been considered.

Specification

4. The disclosure is objected to because of the following informalities:
- pg. 8, lines 4-5 and 8, recite “suitable program 28” and “print data stream 28”, respectively. If the recitation “print data stream 28” is amended to include a different reference character, Fig. 1 may have to be amended to show the reference character. The Examiner recommends amending “print data stream 28” to simply recite “print data stream.”
5. The use of numerous trademarks (e.g., ADOBE, MICROSOFT WORD, etc., (see pg. 8 of substitute specification)) has been noted in this application. Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.
- Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 32-33 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claims 32 and 46, claims 31 and 45, for which claims 32 and 46 depend, require a selection of only one limitation from a group of limitations. Moreover, claims 32 and 46 further limit only one of the several limitations from claims 31 and 45, which does not require selection. This renders the claim indefinite.

In regard to claim 33, the recitation “an areal region of the region is selected given the selection of the part of the region,” is not clearly understood. This renders the claim indefinite.

For purposes of examination, the Examiner will interpret this recitation as meaning simply that a region is selected.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26-35 and 39-48 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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(1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing.

While the instant claims recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, claim 26 is directed to processing of print data, in which the steps recite, “generating a print data stream with data of a plurality of print pages wherein first object properties are associated with at least one region of the print pages; processing the print data wherein at least one part of the at least one region of one of the plurality of print pages of the print data stream is selected; associating at least one second object property differing from the first object properties with the selected part of the region on each of said plurality of print pages of the print data stream; and further processing the print data of each of said plurality of print pages which pertain to the selected part of the region dependent on the at least one second object property.”

The applicant has not provided explicit and deliberate definitions of which particular apparatus is used for the processing of print data, i.e., executing steps of “generating a print data stream with data of a plurality of print pages wherein first object properties are associated with at least one region of the print pages; processing the print data wherein at least one part of the at least one region of one of the plurality of print pages of the print data stream is selected,” etc., or to limit the steps of “generating

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a print data stream with data of a plurality of print pages wherein first object properties are associated with at least one region of the print pages; processing the print data wherein at least one part of the at least one region of one of the plurality of print pages of the print data stream is selected,” etc., for transforming underlying subject matter (such as an article or material) to a different state or thing. Thus, the method of claim 26 would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine, i.e. a set of algorithm or a set of procedures without a machine for execution.

Claim 39 recites essentially the same steps as claim 26, and is rejected under 35 U.S.C. 101 for the same reason as claim 26. Claims 27-35 and 40-48 either directly or indirectly depend from claims 26 and 39 respectively, and therefore are rejected under 35 U.S.C. 101 because of their respective dependence.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-31, 33-37, 39-45, and 47-49 are rejected under 35 U.S.C. 102(b) as being anticipated by International Application Publication No. WO 03/025713 A2 to

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Dexter et al. (hereinafter, Dexter). Dexter was cited in the IDS filed by Applicants on June 02, 2006.

In regard to claim 26, Dexter discloses a method for processing of print data (**Dexter, [0008], lines 6-10**), comprising the steps of:

generating a print data stream with data of a plurality of print pages wherein first object properties are associated with at least one region of the print pages (**Dexter, [0035], lines 1-3, [0037], lines 2-6, and [0044], lines 1-7, the first object properties would be a default object properties used for converting the display data for printing. For example, at [0037], lines 2-4, a user selects at least one region and then selects a region type for the at least one region selected. Accordingly, if the user does not select a region and region type for the selected region, the unselected region would have a default region type for use in the raster image processing described at [0034], line 9**);

processing the print data wherein at least one part of the at least one region of one of the plurality of print pages of the print data stream is selected (**Dexter, [0037], lines 5**);

associating at least one second object property differing from the first object properties with the selected part of the region on each of said plurality of print pages of the print data stream (**Dexter, [0037], lines 6**); and

further processing the print data of each of said plurality of print pages which pertain to the selected part of the region dependent on the at least one second object property (**Dexter, [0038], lines 1-2**).

In regard to claim 36, Dexter discloses a system for processing of print data (**Dexter, Fig. 1**), comprising:

a first data processing unit (**Dexter, Fig. 1, item 18**) which generates a print data stream with print data of a plurality of print pages, at least one first object property being associated with at least one region of the print pages (**Dexter, [0035], lines 1-3, [0037], lines 2-6, and [0044], lines 1-7, the first object properties would be a default object properties used for converting the display data for printing. For example, at [0037], lines 2-4, a user selects at least one region and then selects a region type for the at least one region selected. Accordingly, if the user does not select a region and region type for the selected region, the unselected region would have a default region type for use in the raster image processing described at [0034], line 9**);

a second data processing unit (**Dexter, [0034], line 9, raster image processor**) that processes the print data, wherein at least one part of the at least one region of one of the plurality of print pages of the print data stream is selected (**Dexter, [0037], lines 5**);

at least one second object property differing from the first object property and which is associated with said selected part of the region on each of said plurality of print pages of the print data stream (**Dexter, [0037], lines 6**); and

the second data processing unit further processing the print data of each of said plurality of print pages which pertain to the selected part of the region dependent on the at least one second object property (**Dexter, [0038], lines 1-2**).

In regard to claim 37, Dexter discloses a system for processing of print data (**Dexter, Fig. 1**), comprising:

a first data processing unit (**Dexter, Fig. 1, item 18**) in which a print data stream with print data of a plurality of print pages is generated, at least one first object property being associated with at least one region of the print pages (**Dexter, [0035], lines 1-3, [0037], lines 2-6, and [0044], lines 1-7, the first object properties would be a default object properties used for converting the display data for printing. For example, at [0037], lines 2-4, a user selects at least one region and then selects a region type for the at least one region selected. Accordingly, if the user does not select a region and region type for the selected region, the unselected region would have a default region type for use in the raster image processing described at [0034], line 9**);

a second data processing unit (**Dexter, [0034], line 9, raster image processor**) that processes the print data, at least one part of the region of one of the plurality of print pages of the print data stream being selected (**Dexter, [0037], lines 5**);

at least one second object property differing from the at least one first object property being associated with the selected part of the region on each of said plurality of print pages of the print data stream (**Dexter, [0037], lines 6**); and

a printer (**Dexter, [0035], line 7, selecting a print channel implies there is a printer, see also, [0052], lines 2, "digital press"**) which further processes the print data of each print page that pertain to the selected part of the region dependent on the at least one second object property (**Dexter, [0035], line 7, a printer has to process print data in some way, since a printer is only given a print data stream. This would include processing the print data of each print page that pertain to the selected part of the region dependent on the at least one second object property, as well as processing the rest of the print documents**).

In regard to claim 39, Dexter discloses a method for processing of print data (**Dexter, [0008], lines 6-10**), comprising the steps of:

generating a print data stream with print data of a plurality of print pages, first object properties being associated with at least one region of the print pages (**Dexter, [0035], lines 1-3, [0037], lines 2-6, and [0044], lines 1-7, the first object properties would be a default object properties used for converting the display data for printing. For example, at [0037], lines 2-4, a user selects at least one region and then selects a region type for the at least one region selected. Accordingly, if the user does not select a region and region type for the selected region, the**

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unselected region would have a default region type for use in the raster image processing described at [0034], line 9);

processing the print data wherein image data of the region are determined with which a preset graphic format is associated (**Dexter, [0037], lines 5-9, and [0038], lines 1-2, region type is preset graphic format, the region being determined with which a preset graphic format is associated would have to take place before processing described in [00038], line 1 is completed**); and

further processing the image data dependent on the preset graphic format (**Dexter, [0038], line 1**).

In regard to claim 49, Dexter discloses a system for processing of print data (**Dexter, Fig. 1**), comprising:

a first data processing unit (**Dexter, Fig. 1, item 18**) which generates a print data stream with print data of a plurality of print pages, at least one first object property being associated with at least one region of the print pages (**Dexter, [0035], lines 1-3, [0037], lines 2-6, and [0044], lines 1-7, the first object properties would be a default object properties used for converting the display data for printing. For example, at [0037], lines 2-4, a user selects at least one region and then selects a region type for the at least one region selected. Accordingly, if the user does not select a region and region type for the selected region, the unselected region would have a default region type for use in the raster image processing described at [0034], line 9**);

a second data processing unit (**Dexter, [0034], line 9, raster image processor**) that processes the print data, the data processing unit determining image data of objects of the region to which a preset graphic format is assigned (**Dexter, [0037], lines 5-9, and [0038], lines 1-2, region type is preset graphic format, the region being determined with which a preset graphic format is associated would have to take place before processing described in [00038], line 1 is completed**); and

the second data processing unit further processing the image data dependent on the preset graphic format (**Dexter, [0038], line 1**).

In regard to claim 27, Dexter further discloses wherein a second print data stream is generated in which the at least one second object property is associated with the part of the region of each print page (**Dexter, [0038], lines 1-3**).

In regard to claims 28 and 42, Dexter further discloses wherein the second print data stream is supplied to a printer which processes the selected part of the region of each of the plurality of print pages dependent on the second object property or dependent on the second object property and at least one part of the first object property, and which processes the remaining region dependent on at least one part of the first object property (**Dexter, [0035], line 7, a printer has to process print data in some way, since a printer is only given a print data stream. This would include at least processing the selected part of the region of each of the plurality of print pages dependent on the second object property**).

In regard to claims 29 and 43, Dexter further discloses wherein the region comprises the entire print page (**Dexter, [0037], line 4**).

In regard to claims 30 and 44, Dexter further discloses wherein the first and/or second object property pertains to at least one output, print, and/or processing parameter (**Dexter, [0037], lines 7-9, region type pertains at least a processing parameter**).

In regard to claims 31 and 45, Dexter further discloses wherein at least one object property serves for selection of a color conversion method, a raster conversion method, or an error correction method (**Dexter, [0037], line 8, and [0038], lines 12-13, RBG to CMYK for color photos**).

In regard to claim 33, Dexter further discloses wherein an areal region of the region is selected given the selection of the part of the region (**Dexter, Fig. 5, user selects region**).

In regard to claim 34, Dexter further discloses wherein the areal region is selected with aid of geometric figures comprising at least one of rectangles, circles, or polygons (**Dexter, Fig. 5, user selects region using rectangle**).

In regard to claims 35 and 47, Dexter further discloses wherein an adaptation of a resolution of the print data contained in the print data stream to a resolution of the printer, and/or an adaptation of color and/or grey level values contained in the print data stream to device properties of the printer occurs in print preparation (**Dexter, [0037], lines 5-9, and [0038], lines 1-2, and lines 12-21, the processing is done for printing, and therefore in its broadest sense, occurs in print processing**).

In regard to claim 40, Dexter further discloses wherein at least one second object property differing from the first object properties is associated with the image data dependent on the associated graphic format (**Dexter, [0037], lines 5-6, and line 9, type of region is dependent upon type of being scanned. If a region scanned contains text, a user would select text line art 312, therefore at least one second object property differing from the first object properties is associated with the image data dependent on the associated graphic format**).

In regard to claim 41, Dexter further discloses wherein a second print data stream is generated in which the second object property is associated with image data of the region (**Dexter, [0037], lines 5-6, and [0038], lines 1-3**).

In regard to claim 48, Dexter further discloses wherein the region contains a plurality of data groups with which a graphic format is respectively associated, wherein image data of the respective image data group are respectively further dependent on an

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associated graphic format (**Dexter, [0037], line 4, region is entire scanned document and therefore the region can be contains a plurality of data groups, the graphic format would be the default region type applied before a user selects a region type).**

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 32, 38, 46, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dexter.

In regard to claims 32 and 46, Dexter discloses the claimed invention except for the raster method comprising a Floyd-Steinberg raster method, a Burkes raster method, or a Stucki raster method.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the raster method comprising at least a Floyd-Steinberg raster method since it was known in the art that the Floyd-Steinberg raster method is commonly used in image manipulation software.

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In regard to claims 38 and 50, Dexter discloses the claimed invention expect that wherein the second data processing unit is arranged in the printer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the second data processing unit in the printer, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure and is as follows:

Rumph et al., U.S. Patent Application Publication No. 2001/0043345 A1, teaches an optimized printing system and method employing object types for print data.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Tieu can be reached on (571)-272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. A. R./

Examiner, Art Unit 2625

08/26/2009

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625